

The opinion in support of the decision being entered today was *not* written for publication and is *not* precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TOSHIAKI FUJII,  
TSUKURU SUZUKI,  
HIDETOMO SUZUKI and  
KAZUHIKO SAKAMOTO

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Appeal No. 1997-1728  
Application No. 08/424,545

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HEARD: OCTOBER 10, 2000

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Before KIMLIN, PAK and DELMENDO, *Administrative Patent Judges*.  
DELMENDO, *Administrative Patent Judge*.

*REMAND TO THE EXAMINER*

We return the subject application, in which we rendered a decision on appeal under 35 U.S.C. § 134 on October 27, 2000,<sup>1</sup> to the examiner for appropriate action on a paper filed by the

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<sup>1</sup> We affirmed the examiner's rejections in our October 27, 2000 decision, but we designated our affirmance as a new ground of rejection under 37 CFR § 1.196(b) (1997) because we relied on a newly cited prior art reference and the appellants' admitted prior art.

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appellants on October 20, 2000 and entitled "Information Disclosure Statement Under 37 CFR 1.97" (Paper 23).

The above-identified information disclosure statement includes an attachment which lists the following:

- (1) the present application; and
- (2) copending Application No. 09/620,247 filed July 20, 2000.

Further, the information disclosure statement states as follows:

No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this statement.

On return of this application, we trust that the examiner will take appropriate action, including determining whether the information disclosure statement complies with the requirements of the applicable version of 37 CFR §§ 1.97 and 1.98, considering the information to the extent that it is warranted, and notifying the appellants accordingly.

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This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D)(7th ed., Rev. 1, Feb. 2000). It is important that the Board be promptly informed of any action affecting our decision on appeal in this case.

*REMANDED*

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
CHUNG K. PAK	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS
	)	AND
	)	INTERFERENCES
	)	
	)	
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

RHD:ki

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